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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested. Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1 - 12 are pending in the application. Claims 1 – 12 have been rejected. Claims 13 - 23 have been cancelled without prejudice or disclaimer. Applicants reserve all rights in these claims to file divisional and/or continuation applications. Claim 1 has been voluntarily amended for clarification only. This amendment is not being made for reasons of patentability as explained below with respect to the § 102 rejection.

ELECTION/RESTRICTION

Applicants elect without traverse to prosecute the invention of Group I, claims 1 - 12. Claims 13 – 23 are cancelled. Applicant reserves all rights to file divisional application(s) for the non-elected subject matter.

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1 – 9 under 35 U.S.C. § 102(b), as being anticipated by Teng (US 6,245,486). Applicants respectfully traverse the rejection of claims 1 - 9 in view of the remarks that follow.

As is well established, in order to successfully assert a *prima facie* case of anticipation, the Examiner must provide a single prior art document that includes every element and limitation of the claim or claims being rejected.

Claim 1 recites: "*said laser-absorbing layer is a gradient solid dispersion of metal and metal-oxide areas such that concentration ratios between the metal and the metal-oxide vary throughout a thickness of said laser-absorbing layer*"

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Teng does not teach, either expressly or inherently, all the elements of claim 1. Teng does not teach, at least, "*said laser-absorbing layer is a gradient solid dispersion of metal and metal-oxide areas such that concentration ratios between the metal and the metal-oxide vary throughout a thickness of said laser-absorbing layer*", as recited in claim 1.

According to Merriam-Webster online dictionary, the definition of a gradient is: "change in the value of a quantity (as temperature, pressure, or concentration) with change in a given variable and especially per unit distance in a specified direction".

The laser ablative layer of Teng is a mask layer that may be formed by metal deposition. In the Office Action, the Examiner does not contend that Teng teaches a gradient solid dispersion of metal and metal-oxide areas such that concentration ratios between the metal and metal-oxide vary throughout the thickness of said layer. Rather, the Examiner contends that "since the vapor materials are condensed to form a solid dispersion throughout the mask layer, the concentration of the metal/metal oxides would vary throughout the mask layer".

Applicants respectfully assert that in order to achieve a gradient of concentration ration throughout the thickness of the layer, the deposition process should be specifically pre-designed and the process should be carefully controlled. As described in page 7 of the subject application:

"The metal/metal-oxide layer may be deposited over base 102 using a metal vapor deposition process, in which a controlled amount of oxygen is introduced into the metal vapor stream to create the gradient solid deposition."

A standard metal deposition process would not result in gradient solid dispersion of *metal and metal-oxide areas*, as claimed in claim 1. Based on the discussion above, Teng does not teach or suggests "*said laser-absorbing layer is a gradient solid dispersion of metal and metal-oxide areas such that concentration ratios between the metal and the metal-oxide vary throughout a thickness of said laser-absorbing layer*", as recited in claim 1, and therefore claim 1 is allowable and the rejection should be withdrawn.

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Additionally claim 1 has been voluntarily amended to better define what applicants view as their invention. Amended claim 1 recites a printing member that "*is capable of being imaged such that selective areas of said coating layer are removed to expose said base layer.*" The laser-abatable layer taught by Teng is a top mask layer that is completely removed prior to printing. The coating layer taught by Teng is a very thin transparent top layer to protect the mask layer from physical or chemical damage or to prevent the press operator from direct contact with the mask layer during handling (see col. 4, lines 55-60). The thin transparent top layer is likewise completely removed prior to printing and cannot be considered an image-bearing layer.

In view of the above, applicants respectfully submit that claim 1 is allowable. Claims 2 - 12 depend directly or indirectly from claim 1, and thereby include all the limitations of claim 1 as well as additional distinguishing elements. Therefore, claims 2 - 12 are patentable for at least the reasons discussed above with regard to claim 1. In view of the above remarks, Applicants respectfully request that the above rejections of claims 1 - 12 under 35 U.S.C. § 102(b) be withdrawn.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1, 6 and 10 - 12 under 35 U.S.C. § 103(a), as being unpatentable over Takeyama et al. (US 5,691,103).

An obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Takeyama does not teach or disclose all elements of claim 1. Takeyama does not teach or disclose and the Examiner does not contend that Takeyama teaches or discloses, at least "said coating layer and said base layer having different affinities for ink", as recited in claim 1.

Takeyama discloses a recording method used for an optical recording material such as a resist material or an optical disc (see col. 1, lines 23-26). In this method, the image forming material comprises a support and the image forming layer containing a colorant. The image is formed by imagewise exposing the image forming layer to high density energy light to reduce an adhesive force between the image forming layer and the support (see col. 2, lines 45-48). Then, by superposing the image forming layer on an adhesive sheet and peeling the adhesion

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sheet from the image forming material the exposed portions of the image forming material is transferred to the adhesion sheet to form an image (see col. 12, lines 5-10).

In the office Action the Examiner contents that the image forming material of Takeyama is analogous to the laser-absorbing layer claimed in claim 1. The Examiner further contended that the adhesive layer of Takeyama is representative of a coating layer. This analogy is improper as the process described above is not an ablation process; the image forming layer is the top layer; and the adhesive layer is analogous to the paper on which an image would be printed after imaging and inking the printing plate and cannot be considered as part of the "printing plate". Obviously, this is not a printing plate as it can not be used for multiple printing.

As well known, in lithographic printing members, the top image-bearing layer and the base layer have different affinities for ink. The image forming material described by Takeyama is not applicable as a lithographic printing member and accordingly as mentioned above, Takeyama does not teach or disclose that "said coating layer and said base layer having different affinities for ink".

Additionally, Takeyama does not teach or disclose "said laser-absorbing layer is a gradient solid dispersion of metal and metal-oxide areas such that concentration ratios between the metal and the metal-oxide vary throughout a thickness of said laser-absorbing layer", as recited in claim 1. Even if the reference teaches, as contended by the Examiner that "the metal compound may combine with a metal oxide powder as a light-heat converting compound in the image-forming layer, it does not teach or suggest a gradient solid dispersion of metal and metal-oxide areas such that concentration ratios between the metal and the metal-oxide vary throughout a thickness of said laser-absorbing layer", as recited in claim 1. The mere combination of a metal compound and a metal oxide power would not result in a gradient solid dispersion of metal and metal-oxide areas such that concentration ratios between the metal and the metal-oxide vary throughout a thickness of said laser-absorbing layer", as recited in claim 1.

In view of the above, applicants respectfully submit that claim 1 is allowable. Claims 6 and 10 - 12 depend directly or indirectly from claim 1, and thereby include all the limitations of claim 1 as well as additional distinguishing elements. Therefore, claims 6 and 10 - 12 are patentable for at least the reasons discussed above with regard to claim 1. In view

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of the above remarks, Applicants respectfully request that the above rejections of claims 1, 6 and 10-12 under 35 U.S.C. § 103(a) be withdrawn.

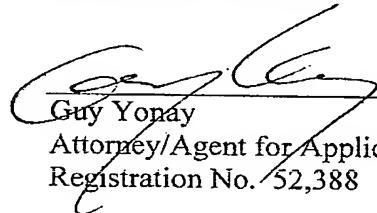
CONCLUSION

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



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